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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,590

07/22/2004

Steve Hansen

6467-0401

4589

24936

7590

05/05/2006

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EXAMINER

JULES, FRANTZ F

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/710,590

Applicant(s)

HANSEN, STEVE

Examiner

Frantz F. Jules

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3, 5, 7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 6-7 of U.S. Patent No.

6,766,963 B2 in view of Jury et al (US 6,262,175 B1).

Claims 1-2, 6-7 of US Patent No. 6,766,963 B2 teach all the limitations of claims 1, 3, 5 and 7 except for a strength enhancing polymer of no more than 5% by weight. The general concept of modifying an existing design structure by reducing a component thereof falls within the realm of common knowledge as obvious mechanical expedient which carry no patentable weight and the specific use of a strength enhancing polymer of less than 5% by weight is well known in the art as illustrated by Jury et al which

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discloses the use of a strength enhancing polymer of 2% vinyl polymer or less than 5% by weight in a rubber composition. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Claims 1-2, 6-7 of US Patent No. 6, 766, 963 to include the use of a strength enhancing polymer of no more than 5% by weight in his advantageous rubber composition as taught by Jury et al in order to achieve a composition having improved physical properties resulting from improved adhesion or bonding between the tire crumb and the remaining components as recited in col 1, lines 63-65 of Marinelli.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jury et al (US 6,262,175) in view of Marinelli (US 6,247,651).

Jury et al discloses a rubber product to be used in load carrying structures comprising a weight ratio of 5 to 90% vulcanized rubber crumb and 2 to 30% uncured or natural rubber including a strength enhancing polymer of 2% vinyl polymer.

Jury et al discloses all of the features as listed above but does not disclose a rubber product used in a cross tie member. The general concept of using a rubber product for fabricating a cross tie falls within the realm of common knowledge as obvious design expedient and is well known in the art as illustrated by Marinelli which discloses the

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teaching of a railway crosstie comprising a weight ratio of 65% recycled plastic, 20% crumb rubber and a strength enhancing polymer. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jury et al to include the use of his advantageous rubber product in a crosstie application as taught by Marinelli in order to achieve a crosstie which is durable in comparison to wooden ties while eliminating environmental hazards as disclosed in col 1, lines 25-50.

Regarding the limitation of milling said blend at between 240 to 380 degrees to form an intermediate product and extruding said intermediate product at the same temperature range to form an extrusion having specific width and depth, these are inherently included in the finish product of Marinelli which discloses a finish crosstie of recycled rubber which has been made through a molding process including the steps of milling and extrusion at high temperature. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jury et al to include the process steps of milling said blend at between 240 to 380 degrees to form an intermediate product and extruding said intermediate product at the same temperature range to form an extrusion having specific width and depth as inherently taught by Marinelli in order to achieve among other the benefit of reducing internal stress in the finish crosstie.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jury et al (US 6,262,175) and Marinelli (US 6,247,651), as applied to claims 1 and 8 above, and further in view of Oestmann (US 5,104,039).

Jury et al and Marinelli teach all the limitations of claim 1 except for a crosstie having at least one longitudinal side which has a plurality of indentations. The general concept of

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providing a plurality of indentations to a longitudinal side of a tie is well known in the art as illustrated by Oestmann which discloses the teaching of a plurality of indentations in the longitudinal sides of a crosstie, see figs. 6-7, col 1, lines 62-68. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jury et al and Marinelli to include the use of a plurality of indentations in at least one longitudinal sides of the crosstie as taught by Oestmann in order to obtain maximum traction of the ties on uneven surface such as ballast bed, prevent lateral movement of the tie thereby increasing the stability of the track bed.

6. Claims 4 and 6-7, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jury et al (US 6,262,175) and Marinelli, as applied to claims 3 above, and further in view of Smith (US 6,021,958).

Jury et al and Marinelli teach all the limitations of claims 4, 6-7, 9 except for a crosstie comprising a plurality of pre-holes on one longitudinal side of the crosstie corresponding to spikes holes. The general concept of providing a plurality of pre-holes on one longitudinal side of the crosstie corresponding to spikes holes is well known in the art as illustrated by Smith which discloses the teaching of a plurality of pre-holes on one longitudinal side of the crosstie corresponding to spikes holes, see figs. 1-2. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Jury et al and Marinelli to include the use of a plurality of pre-holes on one longitudinal side of the crosstie corresponding to spikes holes as taught by Smith in order to provide for location of a rail onto the tie.

### ***Response to Arguments***

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7. Applicant's arguments filed 02/16/2006 have been fully considered but they are moot in view of the new grounds of rejection.

Applicant's argument that "there is no teaching in Marinelli or in Jury et al, that suggest or teach that the composition disclosed in Jury et al can be used for crossties.

Combining of the references is therefore improper" is weak in light of the fact that there is no limit imposed on the type of products that the rubber/elastomer composition of Jury et al can be applied to in the reference. Also, as explained in the rejection above, it is well known in the art as illustrated by Marinelli to use a rubber product for fabricating a cross tie. Therefore, Marinelli establishes a prima facie case of obviousness to one of ordinary skill in the art.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz F. Jules whose telephone number is (703) 308-8780. The examiner can normally be reached on Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

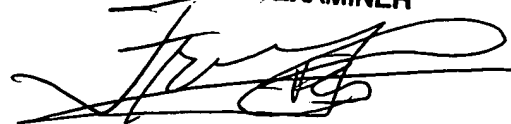
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Frantz F. Jules  
Examiner  
Art Unit 3617

FFJ

October 25, 2005

**FRANTZ F. JULES**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Frantz F. Jules', written over the printed name and title.